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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,949	02/27/2004	Johannes Lauterbach	000005-006500US	5789
68155 7590 09/28/2007 FOUNTAINHEAD LAW GROUP, PC 900 LAFAYETTE STREET SUITE 509 SANTA CLARA, CA 95050			EXAMINER KISS, ERIC B	
			ART UNIT 2192	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,949

Applicant(s)

LAUTERBACH ET AL.

Examiner

Eric B. Kiss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20040430, 20070712.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 have been examined.

Information Disclosure Statement

2. The listing of references in the specification, (see Specification at p. 19,) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 17 contain the trademarks/trade names VBA, JAVA, and JAVASCRIPT. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or

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describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe particular programming languages and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 14-17 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1760 (claim to a data structure *per se* held nonstatutory).

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. *See, e.g.; In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any

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structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035.

Claims 14-17 purport to set forth articles of manufacture comprising computer-usable media. Although the specification describes the use of "computer-readable media" in the context of carrier 970, which is distinct from signal 980 (the examiner notes that the word "carrier" is not being used in the context of a modulated carrier wave, which would likewise be a signal), (Specification at p. 15,) applicant's claims recite computer-usable media, which may be broadly construed as embracing within its scope signal 980, described in the specification as also capable

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of embodying computer program product 100, (*Id.*). Accordingly, claims 14-17 can be reasonably construed to cover signals encoded with functional descriptive material. The Office's current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. *See* 1300 OG 142 (November 22, 2005) (in particular, see Annex IV(c)); *see also In re Nuijten*, Case No. 2006-1371, at *11 (Fed. Cir., September 20, 2007).

Claim 20 recites a "computer system" comprising a series of means that can be reasonably interpreted as software. (*See* Specification at p. 17, lines 8-16.) Accordingly, claim 20 appears to merely set forth functional descriptive material *per se*, which is nonstatutory.

7. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. §101 (non-statutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Eduardo Pelegrí-Llopart, ed., “JavaServer Pages™ Specification,” Version 1.2, August 27, 2001, Sun Microsystems, Inc. (hereinafter “Sun2001”).

Regarding claim 1, *Sun2001* discloses a method for providing a library that is adapted to be instantiated into a runtime object (*see, e.g., Sun2001* at JSP.7.2 (describing tag libraries)), the method comprising:

providing a template that corresponds to the structure of the runtime object with element placeholders for elements and with attribute placeholders for attributes (*see, e.g., Sun2001* at sections JSP.1.1 and JSP.1.2 (describing templates, and adding dynamic data to template data); section JSP.2.13 (describing handling of attributes));

providing classes that form the library, wherein the classes correspond to the elements and the classes have replacement instructions for the placeholders, with the replacement instructions activated upon instantiating into the runtime object (*see, e.g., Sun2001* at Chapter JSP.7 (describing tag libraries)).

Regarding claim 2, *Sun2001* further discloses the template includes element placeholders having start portions and end portions differentiated by tag types (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers and various tag types)).

Regarding claim 3, *Sun2001* further discloses the template includes element placeholders having element identification components belonging to the start portions and the end portions (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers and various tag types)).

Regarding claim 4, *Sun2001* further discloses the element placeholders include element placeholders for a root element and for a branch element, with the start portions and the end portions of the branch element placed between the start portions and the end portions of the root element (*see, e.g., Sun2001* at sections JSP.7.1.3 (describing tag handlers, including branches within tags (conditionals and iteration tags))).

Regarding claim 5, *Sun2001* further discloses the template includes the attribute placeholders placed between the start portions and the end portions of the element placeholders (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers accessing attributes of tags)).

Regarding claim 6, *Sun2001* further discloses the template includes code portions in the language of the runtime object placed between the start portions and the end portions of the element placeholders (*see, e.g., Sun2001* at section JSP.7.1.3 (describing tag handlers and associated actions (code portions))).

Regarding claim 7, *Sun2001* further discloses, in providing the template, single placeholders that represent a plurality of elements include a plurality indicator for indicating that the single placeholders represent a plurality of elements (*see, e.g., Sun2001* at sections JSP.7.1.3.4 and JSP.7.1.3.5 (describing iterations))).

Regarding claim 8, *Sun2001* further discloses, in providing classes, the attribute placeholder changes a form of tags from tags of a first type into tags of a second type (*see, e.g., Sun2001* at section JSP.7.1.2 (describing the translation of tags from XML to a JSP page implementation)).

Regarding claim 9, *Sun2001* further discloses providing classes comprises using XML-techniques (*see, e.g., Sun2001* at section JSP.7.1 (a tag library is described via the tag library descriptor (TLD), and XML document)).

Regarding claim 10, *Sun2001* further discloses providing classes comprises organizing the classes in an abstract syntax tree (AST) (defined by applicant as, “any computer-internal hierarchy representation of an object, a class or a library,” (Specification at p. 5, lines 4-5). (*see, e.g., Sun2001* at section JSP.7.1.3.6 (describing a nested structure of actions to describe scoping))).

Regarding claim 11, *Sun2001* further discloses the template and classes are provided such that the library is adapted to be instantiated into a runtime object selected from the group consisting of application class file, application project file, common registry, machine specific registry, business component, and website layout (*see, e.g., Sun2001* at section JSP.1.1 (describing general uses of JSP, including web applications (business component and website layout))).

Regarding claim 12, *Sun2001* further discloses the template and the classes are provided such that the library is adapted to be instantiated into a runtime object in a language selected from the group consisting of VBA, HTML, C++, C, Java, JavaScript, XML, and WML (*see, e.g., Sun2001* at section JSP.1.1).

Regarding claim 13, *Sun2001* further discloses each element has associated attributes (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers accessing attributes of tags)), further comprising:

identifying data for the attributes associated with each of the elements (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers accessing attributes of tags)); and

instantiating the classes by activating the replacement instructions to replace the attribute placeholders with the data (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers accessing attributes of tags)).

Regarding claim 14, Sun2001 discloses an article of manufacture comprising a computer-usable medium storing computer-readable program code for causing a processor to perform operations (*see, e.g., Sun2001* at section JSP.2.1.3 (describing generally execution involving a server and client, necessarily requiring processors and memory)) comprising:

providing a runtime object having elements and attributes, with each element having associated ones of the attributes (*see, e.g., Sun2001* at sections JSP.2.1.3 (describing translation and execution of tags) and JSP.7.1.3 (describing tag handlers accessing attributes of tags));

pre-assembling the runtime object using classes in a library, wherein the classes correspond to the elements, the classes include replacement instructions for attribute placeholders, and the classes are based on a template that corresponds to a structure of the runtime object, with the template including element placeholders for the elements and attribute placeholders for the attributes (*see, e.g., Sun2001* at sections JSP.1.1 and JSP.1.2 (describing templates, and adding dynamic data to template data); section JSP.2.13 (describing handling of attributes); Chapter JSP.7 (describing tag libraries));

identifying data for the attributes associated with each of the elements (*see, e.g., Sun2001* at section (describing tag handlers accessing attributes of tags)); and

instantiating the classes by activating the replacement instructions to replace the attribute placeholders with the data (*see, e.g., Sun2001* at sections JSP.2.1.3 (describing translation and execution of tags) and JSP.7.1.3 (describing tag handlers accessing attributes of tags)).

Regarding claim 15, *Sun2001* further discloses the template includes element placeholders having start portions and end portions and the attribute placeholders are placed between the start portions and the end portions of the element placeholders (*see, e.g., Sun2001* at sections JSP.7.1.2.1 and JSP.7.1.3 (describing tag handlers accessing attributes of tags)).

Regarding claim 16, *Sun2001* further discloses the template includes code portions in the language of the runtime object placed between the start portions and the end portions of the element placeholders (*see, e.g., Sun2001* at section JSP.7.1.3 (describing tag handlers and associated actions (code portions))).

Regarding claim 17, *Sun2001* further discloses the library is adapted to be instantiated into a runtime object in a language selected from the group consisting of VBA, HTML, C++, C, Java, JavaScript, XML, and WML (*see, e.g., Sun2001* at section JSP.1.1).

Regarding claim 18, *Sun2001* discloses a computer program stored on a computer-readable medium and comprising processor instructions for providing a library adapted to be instantiated into a runtime object (*see, e.g., Sun2001* at sections JSP.2.1.3 (describing generally execution involving a server and client, necessarily requiring processors and memory); *Sun2001* at section JSP.7.2 (describing tag libraries)), the processor instructions comprising:

first instructions for providing a template that corresponds to a structure of the runtime object with element placeholders for elements and with attribute placeholders for attributes (*see,*

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e.g., *Sun2001* at sections JSP.1.1 and JSP.1.2 (describing templates, and adding dynamic data to template data); section JSP.2.13 (describing handling of attributes)); and

second instructions for providing classes that form the library, wherein the classes correspond to the elements and the classes have replacement instructions for the placeholders that are activated upon instantiating into the runtime object (*see, e.g.*, *Sun2001* at Chapter JSP.7 (describing tag libraries)).

Regarding claim 19, *Sun2001* further discloses the library is adapted to be instantiated into a runtime object selected from the group consisting of application class file, application project file, common registry, machine specific registry, business component, and website layout (describing general uses of JSP, including web applications (business component and website layout))).

Regarding claim 20, *Sun2001* discloses a computer system for providing a library adapted to be instantiated into a runtime object (*see, e.g.*, *Sun2001* at JSP.7.2 (describing tag libraries)), the computer system comprising:

means for providing a template that corresponds to a structure of the runtime object with element placeholders for elements and with attribute placeholders for attributes (*see, e.g.*, *Sun2001* at sections JSP.1.1 and JSP.1.2 (describing templates, and adding dynamic data to template data); section JSP.2.13 (describing handling of attributes)); and

means for providing classes that form the library, wherein the classes correspond to the elements and the classes have replacement instructions for the placeholders that are activated upon instantiating into the runtime object (*see, e.g.*, *Sun2001* at Chapter JSP.7 (describing tag libraries)).

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature should be directed to the TC 2100 Group receptionist: 571-272-2100.



Eric B. Kiss
September 26, 2007